REMARKS

In view of the amendments proposed above, Applicants respectfully request consideration of the following remarks.

Rejections Under 35 U.S.C. § 112

Claims 1-63 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. More specifically, the Examiner stated that in claims 1, 8, and 19, the limitation "A method" was recited and there "is insufficient antecedent basis for this limitation in the claim." Similarly, as to claim 29, the Examiner stated that there was insufficient antecedent basis for the limitation of "A system", and regarding claims 36, 43, and 54, the Examiner stated that there was insufficient antecedent basis for the limitation "A article of manufacture". Office Action, at pg. 2.

The limitations referred to above in each of claims 1, 8, 19, 29, 36, 43, and 54 appear in the preamble of each of these claims and, furthermore, these limitations appear first in the preamble of each of these claims. It is therefore unclear why the Examiner is suggesting that these limitations lack sufficient antecedent basis. For example, it is unclear how the appearance of the word "method" in the preamble of claim 1 could lack antecedent basis when this is the first appearance of the limitation "method" in claim 1.

If the Examiner is suggesting the above-noted limitations lack antecedent basis in the specification, the Examiner's attention is respectfully drawn to M.P.E.P. § 2173.05(e), which states, in part:

> The mere fact that a term or phrase used in the claim has no antecedent
> basis in the specification disclosure does not mean, necessarily, that the term or
> phrase is indefinite. There is no requirement that the words in the claim must
> match those used in the specification disclosure. Applicants are given a great
> deal of latitude in how they choose to define their invention so long as the terms
> and phrases used define the invention with a reasonable degree of clarity and
> precision.

It is also noted that the terms "method" and "system" appear in the title of the patent application.

Rejections Under 35 U.S.C. § 101

The Examiner rejected claims 1-63 under 35 U.S.C. § 101, stating that the "claimed invention is directed to non-statutory subject matter." The Examiner further states that:

> Claims 1-63 . . . are not statutory because they merely recite a number of
> computing steps without producing any tangible result and/or being limited to a
> practical application within the technological arts. The use of a computer has
> not been indicated. Office Action, at pg. 3.

Firstly, independent claims 1, 8, and 19 have each been amended to clarify that these claims are directed to a computer implemented method. Similarly, independent claim 29 has been amended to clarify that this claim is directed to a computer system, and each of independent claims 36, 43, and 54 has been amended to clarify that each is directed to an article of manufacture including a computer readable medium. Secondly, the claimed embodiments produce a tangible result and/or are directed to a practical application within the technological arts. More specifically, the claimed embodiments

relate to methods, systems, and articles of manufacture that, in part, provide for the association of a certificate signing request with a signed certificate received from a certificate authority. In addition, the Examiner is respectfully reminded that:

> Office personnel have the burden to establish a prima facie case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. **Only when the claim is devoid of ay limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101.** M.P.E.P. § 2106(II)(A) (emphasis added).

Anticipation Rejections Under 35 U.S.C. § 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Anticipation Rejection Based on United States Patent 6,055,636 to Hillier et al.

Claims 1-5, 7, 36-40, and 42 were rejected under 35 U.S.C. § 102(b) as being anticipated by United States Patent 6,055,636 to Hillier et al. (hereinafter "Hillier"). Applicants respectfully traverse this rejection as set forth below.

Independent claim 1 recites:

> 1. A computer implemented method comprising:
> reading distinguished name data from a signed certificate received from a
> certificate authority; and

searching a data structure **to identify a certificate signing request associated with** the signed certificate, the identified certificate signing request corresponding to the read distinguished name data.

Independent claim 36 recites some limitations similar to those recited in independent claim 1.

As claimed, the embodiment of claim 1 is directed to a computer implemented method which includes reading distinguished name data from a signed certificate that has been received from a certificate authority and searching a data structure to identify a certificate signing request associated with the signed certificate, wherein the identified certificate signing request corresponds with the distinguished name data.

Hillier is generally directed to a method and apparatus for centralizing the processing of key and certificate life-cycle management. Column 2, Lines 36-38. Hillier does not, however, disclose the identification of a certificate signing request that is associated with a signed certificate. Hillier does not even mention certificate signing requests.

In rejecting claim 1, the Examiner states that with "respect to claim 1, Hillier teaches a method comprising . . . searching a data structure to identify a certificate signing request associated with the signed certificate (column 3, lines 29-31)." The text of Hillier referenced in the above passage provides: "The retrieval of the relevant security information 42 may be done by accessing a directory, a server/manager, and/or by accessing internal memory of the computing device." However, the "relevant security information" referred to in Hillier is not, or does not include, a certificate signing request. Rather, as described in Hillier:

> The relevant security information 42 may include a complete list of the security
> information, an indication of the security information that has changed, and/or
> the changed security information.
>
> ***
>
> Recall that the security information includes an encryption key pair, a
> corresponding encryption public key certificate, a signing key pair, and/or a
> corresponding verification public key certificate. Column 3, Lines 33-36, 41-45.

Thus, as Hillier fails to disclose at least the above-noted limitations of independent claims 1 and 36, each of these claims is novel in view of Hillier. Also, claims 2-5 and 7 are allowable as depending from novel independent claim 1, and claims 37-40 and 42 are allowable as depending from novel independent claim 36.

Obviousness Rejections Under 35 U.S.C. § 103

To reject a claim or claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a prima facie case of obviousness. M.P.E.P. § 2142. When establishing a prima facie case of obviousness, the Examiner must set forth evidence showing that the following three criteria are satisfied:

> First, there must be some suggestion or motivation, either in the references
> themselves or in the knowledge generally available to one of ordinary skill in
> the art, to modify the references or to combine teachings. Second, there must
> be a reasonable expectation of success. Finally, the prior art references (or
> references when combined) must teach or suggest all the claim limitations.
> M.P.E.P. § 2143.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the

applicant's disclosure. M.P.E.P. § 2142 (citing *In re Vaeck*, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991)). Also, the evidentiary showing of a motivation or suggestion to combine prior art references "must be clear and particular." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999).

Obviousness Rejection Based on United States Patent 6,055,636 to Hillier et al. in View of *HOW TO: Enable SSL for All Customers Who Interact with Your Web Site*

Claims 6 and 41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hillier in view of *HOW TO: Enable SSL for All Customers Who Interact with Your Web Site*, Microsoft, October 2001 (hereinafter "*HOW TO: Enable SSL*". Applicants respectfully traverse this rejection as set forth below.

As set forth above, Hillier fails to disclose the identification of a certificate signing request that is associated with a signed certificate. *HOW TO: Enable SSL* discloses a process for generating a certificate signing request (CFR); however, this reference also fails to disclose the limitations of "searching a data structure to identify a certificate signing request associated with the signed certificate."

Accordingly, as Hillier and *HOW TO: Enable SSL*, either individually or in combination, fail to disclose at least the above-noted limitations of independent claims 1 and 36, each of these claims is nonobvious in view of these references. If an independent claim is nonobvious, then any claim depending from the independent claim is also nonobvious. M.P.E.P. §2143.03 (citing *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)). Therefore, claims 6 and 41 are allowable as depending from nonobvious independent claims 1 and 36, respectively.

Obviousness Rejection Based on United States Patent 6,055,636 to Hillier et al. in View of United States Patent 6,067,623 to Blakley, III et al.

Claims 8-11, 14-18, 19-28, 29-35, 43-46, 49-53, and 54-63 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Hillier in view of United States Patent 6,067,623 to Blakley, III et al. (hereinafter "Blakley"). Applicants respectfully traverse this rejection as set forth below.

Independent claim 8 recites:

> 8. A computer implemented method comprising:
> providing a mapping table including distinguished name data for each of a plurality of certificate signing requests;
> extracting distinguished name data from a signed certificate received from a certificate authority; and
> **comparing the extracted distinguished name data with the mapping table data to identify a certificate signing request associated with the signed certificate from the plurality of certificate signing requests.**

Independent claim 43 recites some limitations similar to those recited in independent claim 8.

Independent claim 19 recites:

> 19. A computer implemented method comprising:
> generating a certificate signing request, the certificate signing request including distinguished name data;
> storing the distinguished name data in a mapping table;
> transmitting the certificate signing request to a certificate authority;
> receiving a signed certificate from the certificate authority, the signed certificate including distinguished name data;

extracting the distinguished name data from the signed certificate; and

comparing the extracted distinguished name data with the stored

distinguished name data contained in the mapping table to identify

the certificate signing request.

Independent claim 54 recites some limitations similar to those recited in

independent claim 19.

Independent claim 29 recites

29.   A computer system comprising:

a memory coupled with a bus, the memory having a mapping table resident

thereon; and

a processing device coupled with the bus, the processing device programmed to

perform operations including

reading distinguished name data from a signed certificate received

from a certificate authority, and

searching the mapping table to identify a certificate signing

request associated with the signed certificate, the

identified certificate signing request corresponding to

the read distinguished name data.

As previously set forth Hillier would fail to disclose the limitations of:

"comparing the extracted distinguished name data with the mapping table data to identify

a certificate signing request associated with the signed certificate from the plurality of

certificate signing requests" (re: claims 8 and 43); "comparing the extracted distinguished

name data with the stored distinguished name data contained in the mapping table to

identify the certificate signing request" (re: claims 19 and 54); and "searching the

mapping table to identify a certificate signing request associated with the signed

certificate, the identified certificate signing request corresponding to the read

distinguished name data" (re: claim 29). Blakley is directed to a system and method for controlling middle tier server authentication to enterprise resources. <u>Column 3, Lines3-5</u>. However, Blakley also fails to disclose the above-noted limitations of claims 8, 19, 29, 43, and 54.

Thus, as Hillier and Blakley, either individually or in combination, fail to disclose the above-noted limitations of independent claims 8, 19, 29, 43, and 54, each of these claims is nonobvious in view of these references. Also, if an independent claim is nonobvious, then any claim depending from the independent claim is also nonobvious. M.P.E.P. §2143.03 (citing *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)). Therefore, claims 9-11 and 14-18 are allowable as depending from nonobvious independent claim 9, claims 20-28 are allowable as depending from nonobvious independent claim 19, claims 30-35 are allowable as depending from nonobvious independent claim 29, claims 44-46 and 49-53 are allowable as depending from nonobvious independent claim 43, and claims 55-63 are allowable as depending from nonobvious independent claim 54.

<u>Obviousness Rejection Based on United States Patent 6,055,636 to Hillier et al. in View of United States Patent 6,067,623 to Blakley, III et al. and Further in View of *HOW TO: Enable SSL for All Customers Who Interact with Your Web Site*</u>

Claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hillier in view of Blakley and further in view of *HOW TO: Enable SSL*. Applicants respectfully traverse this rejection as set forth below.

For the reasons set forth above, Hillier, Blakley, and HOW TO: Enable SSL, either individually or in combination, fail to disclose all limitations of independent claim

8 and, therefore, claim 8 is nonobvious in view of these references. If an independent

claim is nonobvious, then any claim depending from the independent claim is also

nonobvious. M.P.E.P. §2143.03 (citing *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)).

Therefore, claim 17 is allowable as depending from nonobvious independent claim 8.

Claim Objections - Allowable Subject Matter

Claims 12, 13, 47, and 48 were objected to as being dependent upon a rejected

base claim, but each of these claims would be allowable if rewritten in independent form.

Office Action, at page 10. Applicants note with appreciation the Examiner's indication

of allowable subject matter. However, as set forth above, each of independent claims 8

and 43 is patentable in view of the cited prior art. Thus, Applicants submit that each of

claims 12, 13, 47, and 48 is patentable as written in dependent form.

Docket No. P13066   Serial No. 10/037,239
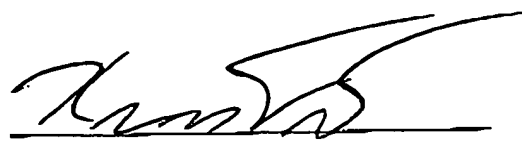
CONCLUSION

Applicants submit that claims 1-63 are in condition for allowance and respectfully

request allowance of such claims.

Please charge any shortages and credit any overages to Deposit Account

No. 02-2666.

Respectfully submitted,

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Date: July 29, 2004

Kerry D. Tweet
Registration No. 45,959

Technology Center 2100

12400 Wilshire Blvd.
Seventh Floor
Los Angeles, CA 90025
(503) 684-6200

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